

67 431533



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/431,533	11/03/89	MORTON	D P318462

DAVID L. PARKER, ESQ.  
ARNOLD, WHITE AND DURKEE  
P.O. BOX 4433  
HOUSTON, TEXAS 77210

18N1/0529

SIDBERRY EXAMINER	
ART UNIT	PAPER NUMBER
1802	47

DATE MAILED:

05/29/96

Below is a communication from the EXAMINER in charge of this application

## COMMISSIONER OF PATENTS AND TRADEMARKS

## ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run \_\_\_\_\_ or continues to run \_\_\_\_\_ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).☒ Applicant's response to the final rejection, filed 4/29/96 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:1. ☒ The proposed amendments to the claim and /or specification will not be entered and the final rejection stands because:

- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- b. ☒ They raise new issues that would require further consideration ~~and/or search~~. (See Note).
- c. ☐ They raise the issue of new matter. (See Note).
- d. ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

SEE ATTACHED2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.3. ☒ Upon the filing an appeal, the proposed amendment ☐ will be entered ☒ will not be entered and the status of the claims will be as follows:

Claims allowed: NONE

Claims objected to: NONE

Claims rejected: 19, 62-65

However;

☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_4. ☒ The affidavit, ~~exhibit~~ <sup>AND</sup> or request for reconsideration has been considered but does not overcome the rejection because SEE ATTACHED5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.☐ Other

*HP*  
HAROLD P. SIDBERRY  
PRIMARY EXAMINER  
GROUP 1800

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The Examiner acknowledges the response under 37 CFR 1.116.

5 The amendment will not be entered because, it does not place the application in condition for appeal by simplifying the issues. The use of the term would incur a rejection under 35 USC 112, 1st and 2nd paragraph as being vague and indefinite, as it unclear what Applicant intends.

10 The amendment to the claims, raises issues which were raised previously. The use of induction implies that no antibody is present, and the use of enhance suggests that antibody is present and further administration of the antigen is required to "enhance" that which is present.

15 The use of this term further appears to have no basis in the specification as no host was immunized with the UTTA, and then given the UTTA antigen to show enhanced antibody.

The Examiner has considered the further submitted declarations.

The declaration of Dr. Gupta is unexecuted.

20 The declaration of Dr. has been considered.

Dr. Gupta indicates that P7A5 was directed to the "same" antigen as the other antibodies in the Paulie reference. The Paulie et al reference cites a 92K; a 190K and 170K. (see at least the Summary) The statement that "antibody P7A5 is directed to the same antigen as the other antibodies in the Paulie reference" is not sufficient clarification.

25 Dr. Gupta indicates that a "confirming" letter "from Dr. Paulie is attached" However, the corroborating letter of Dr. Paulie referenced by Dr. Gupta is not attached, and therefore cannot be considered.

30 Regarding the declaration of Dr. Reisfeld. Dr. Reisfeld maintains that the abstract is noneabling, because it "lacks the information necessary to accomplish" "the isolation and purification of UTAA".

35 The abstract indicates that urine samples were fractionated by dye ligand and gel filtration chromatography, DEAE anion exchange

or 4.5% polyethylene glycol precipitation. UTAA in the IgG and IgM fractions was recovered by gel filtration chromatograph. This material was separated into four bands by SDS-PAGE, two which, 142 kd and 111 kd. The antigen is at least substantially pure, as of  
5 the claims.

Page 33 of the specification indicates "a variety of chromatographic and affinity absorption techniques were employed to isolate and characterize UTAA from positive serum".

The claims recite "substantially pure". The disclosure of Euhus et al would allow the person of skill in the art to obtain a UTAA antigen within the scope of the claims.  
10

The previously set forth rejections of Papers No. 41:

(1) The rejection of claims 16 and 62 under 35 U.S.C. § 102(b) as being anticipated by Real et al is maintained for reasons of  
15 record.

(2) The rejection of claims 62-64 rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 as obvious over Paulie et al or Euhus et al is maintained for reasons of record.

(3) The objection to the specification and the rejection of claims 19 and 65 under 35 U.S.C. § 112, first paragraph, regarding the issue of enhancing the production of antibodies is maintained for reasons of record.  
20

(4) The objection to the specification and the rejection of claims 62 and 65 under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure is maintained for reasons of record.  
25

Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. Sidberry whose telephone number is (703) 308-0170.  
30

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Sidberry/hfs  
35 May 29, 1996

  
HAZEL F. SIDBERRY  
PRIMARY EXAMINER  
GROUP 1800